

Remarks

Upon entry of the foregoing amendment, claims 1, 11, 17, 19, and 22-58 will be pending in the instant application. Claims 2-10, 12-16, 18, 20 and 21 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the canceled subject matter in continuing applications. Claims 25-58 have been added to claim embodiments that Applicants regard as the invention. Support for the amendments to the specification and claims is found throughout the specification as filed.

In addition, the title has been amended to more precisely reflect the presently claimed invention and the current status of priority applications has been updated in the first paragraph of the application. No new matter has been introduced.

Provisional Election With Traverse

Claims 2-10, 12-16, 18, 20 and 21 have been canceled without prejudice or disclaimer.

The Examiner has required an election under 35 U.S.C. § 121 of one of eight groups cast by the Examiner. The Examiner contends that the individual groupings are distinct, each from each other.

Preliminarily, Applicants point out that new claims 25-58 fall within the domain of Group III as cast by the Examiner.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group III, drawn to antibodies, represented by new claims 25-58.

Moreover, in order to be fully responsive, Applicants hereby elect sequences corresponding to polypeptides encoded by the deposited HCE5F43 cDNA and/or that having an amino acid sequence disclosed in SEQ ID NO:125. New claims 25-58 read on the elected sequences.

With respect to the Examiner's division of the invention into eight groups and the reasons stated therefor, Applicants respectfully traverse.

Applicants point out, that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain of the claims this is especially true

because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide. *See*, for example, Figure 1A of Reference AA submitted herewith in PTO/SB/08.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Moreover, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used to treat disease states.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, antibodies, and methods of diagnosing and treating disease states using the proteins of the subject invention would clearly be overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-VIII together in the present application.


Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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